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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/560,397 | 04/28/2000 | Stephen K. Boyer | 01-063 | 4303 |

20306 7590 12/23/2003

MCDONNELL BOEHNEN HULBERT & BERGHOFF
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CHICAGO, IL 60606

EXAMINER

WOO, ISAAC M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2172

DATE MAILED: 12/23/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,397

Applicant(s)

BOYER ET AL.

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-14,17-23,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-14,17-23,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 September 2003, has been entered.
2. Claims 1, 10 and 19 are currently amended. And claims 1-5, 8-14, 17-23 and 26-27 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8-14, 17-23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S. Patent No. 5,991,751, hereinafter, "Rivette") in view of Lisa Yamonaco, Bonnie Arnwine, Seminar Development Team (DIALOG Patent

Art Unit: 2172

Seminar, from Knight Ridder Information Inc. Strategic Training and Development, 1995), hereinafter, Yamonaco.

With respect to claims 1, 10 and 19, Rivette discloses the method, computer program and system for determining potential licensees for a source patent portfolio comprising one or more patents, devising a set of associated patents wherein each patent in the set of associated patents i) cites as reference a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 86-90, and col. 89, lines 15-53) or ii) is cited as reference by a patent in the source patent portfolio (backward reference, col. 4, lines 13-21, FIG. 86-90, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73); processing all of the patents in the set of associated patents to establish a set of assignees contained in the set of associated patents (by assignees searching), see FIG. 53, col. 28, lines 1-51 and col. 93, lines 21-65.

Rivette discloses establishing a set of remaining assignees by removing from the set of assignees all assignee that are currently licensed, see fig. 104, col. 102, lines 7-67, the system of Rivette can extract licensed assignee, thus, it can extract un-licensed assignees from the patent database, assignee's patents in the set of associated patents, all patents held by assignee, see fig. 104, col. 102, lines 7-67.

Rivette does not explicitly disclose organizing the set of remaining assignees according to a ranking criteria that causes a higher ranking to be given any assignee when the following ratio is greater for that assignee than for other assignees.

However, Yamonaco discloses the DIALOG, searching patent database system, patent citation searching, RANK command to provide remaining patent assignees with the order of ranking number, see page 6-8. This teaches that the DIALOG can extract assignee's rank. Therefore, it would have been obvious to a person having ordinary skill in the art the time of the invention was made to include organizing the set of remaining assignees according to a ranking criteria that causes a higher ranking to be given any assignee when the following ratio is greater for that assignee than for other assignees in the system of Rivette to provide assignees ranking criteria, which provides data list with specific order and user-friendly display.

With respect to claim 2, 11 and 20, Rivette discloses the adding, to the set of associated patents, patents that cite as a reference patents in the original set of associated patents (forward, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) or patents that are cited as a reference by a patent in the original set of associated patents, see backward, col. 4, lines 13-21, FIG. 86, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73.

With respect to claims 3, 12 and 21, Rivette discloses the determining a set of cited references contained in the patents of the source patent portfolio (forwarding references and backward references); adding, to the set of associated patents, patents that contain at least one of the references found in the set of cited references (reference

cited), see col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53; col. 4, lines 13-21; FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73.

With respect to claims 4, 13 and 22, Rivette disclose that the source portfolio (forwarding references) is the set of all patents assigned to a particular assignee, see FIG. 53, col. 28, lines 1-51.

With respect to claims 5, 14 and 23, Rivette disclose that presenting the organized assignees in an HTML document that can be read by an Internet browser, see FIG. 53, col. 10, lines 30-54, col. 28, lines 1-51 and col. 38, lines 25-67 to col. 39, lines 1-13.

With respect to claims 8, 17 and 26, Rivette discloses that the ranking criteria gives more weight to assignees having patents that have commonly cited references with patents in the source patent portfolio, see col. 103, lines 25-67 to col. 104, lines 1-45.

With respect to claims 9, 18 and 27, Rivette discloses that the ranking criteria gives more weight to assignees both i) having patents that have a reference to a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) and ii) having patents that are cited as a reference by a patent in the source patent portfolio, see backward reference, col. 4, lines 13-21; FIG. 86; col. 87, lines 16-

Art Unit: 2172

67 to col. 88, lines 1-67 to col. 89, lines 1-14 and col. 103, lines 25-67 to col. 104, lines 1-45.

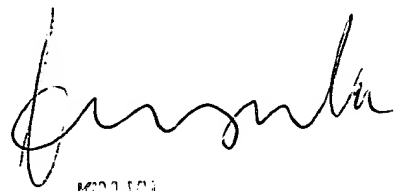
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

IMW
December 15, 2003


ISAC M WOO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100